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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/752,732 | 01/07/2004 | Norman H. Margolus | 11656-004010 | 4745 |

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| EXAMINER | |
|---|---|
| EHICHIOYA, FRED I | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2162 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/752,732 | MARGOLUS, NORMAN H. | |
| | Examiner | Art Unit | |
| | Fred I. Ehichioya | 2162 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *31 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *114 - 116, 164 - 166, and 169 - 173* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *114 - 116, 164 - 166, and 169 - 173* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/31/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 31, 2007 has been entered.

2. Claims 114 - 116, 164 – 166, and 169 - 173 are pending in this Office Action.

### *Remarks/Response to Arguments*

3. Examiner submits that the current amendment to the claims of the instant application does not change the scope of the invention. Therefore, the rejection of last Office Action that is applicable herewith is proper.

Further review of the instant application and Application No. 10/752,838 shows that these inventions fall within the same environment except the omitting of the limitation "testing for whether the content data item is already stored in the data repository by comparing digital fingerprint of the content data item to digital fingerprints of content data items already in storage in the data repository; and ensuring that stored data item . . . already stored in the data repository" from Application No. 10/752,838, it would have be obvious that these applications still achieve the same purpose. Therefore, this warrants a double patenting rejection between instant application and Application No. 10/752,838.

***Claim Objections***

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Claim 172 is not included in the presented claims.

***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 114 - 116, 164 – 166, and 169 - 173 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **Application No. 10/752,838**. The mapping of the similar claims is as following:

| Instant Application **10/752,732** | Application No. **10/752,838** |
|---|---|
| 114 | 164 |

Claim 114 of the instant application recites all the elements of claim 164 of the Application No. **10/752,838.** Although the conflicting claim is not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to exclude the term limitation "testing for whether the content data item is already stored in the data repository by comparing digital fingerprint of the content data item to digital fingerprints of content data items already in storage in the data repository; and ensuring that stored data item . . . already stored in the data repository" from Application No. 10/752,838 because the person would have realized

that the remaining elements would have performed the same functions as before. "Omission of element and its function in combination is obvious expedient if the remaining elements perform same functions as before." See In re Karlson (CCPA) 136 USPQ 184, decide Jan 16, 1963, Appl. No. 6857, U.S. Court of Customs and Patent Appeals.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 114 – 116, and 164 - 169 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub. No. 2002/004626 issued to Heilig et al., (Hereinafter "Heilig") in view of US Pub. No. 2002/0129168 issued to Kanai et al., (Hereinafter "Kanai") and further in view of U.S. Patent No. 6,636,953 issued to Yuasa et al (hereinafter "Yuasa").

Regarding claim 114, Heilig discloses a method by which multiple clients browse content on a network and preserve access indefinitely to content that is no longer on the network, the method comprising:

retrieving for each of the multiple clients, data items of content stored at network storage locations, accessing the content data items via a proxy servers (see page 2, [0031]);

providing a data repository different from the network storage location and connected to the proxy server (see Fig. 4 step 412).

Heilig does not explicitly teach digital fingerprint or expiration time as claimed.

Kanai discloses determining a digital fingerprint of a content data item that is a one of the data items of content retrieved for a one of the multiple clients from a one of the network storage locations (page 12, [0209]: "a method for checking the data corresponding to the fingerprints recorded in the log table");

testing for whether the content data item is already stored in the data repository by comparing the digital fingerprint of the content data item to the digital fingerprints of content data items already in storage in the data repository (page 16, [0280]: "checks whether the data having this fingerprint name exists in the fingerprint cache 234 or not");

ensuring that a stored data item identical to the content data item exist in the data repository by storing the content data item in the proxy repository if comparing establishes that a data item identical to the content data item is not already in the data repository (page 16, [0280]: "checks whether the data having this fingerprint name exists in the fingerprint cache 234 or not. Here it does not exist, so that it is the first time data and this data is entered (registered) into the fingerprint cache"), and not storing the content data item in the data repository if comparing establishes that a data item identical to the content data item is already in the proxy repository (see page 16, [0276]:

"in which case the other data that gives the same fingerprint as the registered fingerprint will not be cached");

associating the stored data item with an access authorization credential uniquely associated with the one of the multiple clients or a person associated with the one (page 1, [0014]).

Further, Yuasa discloses assigning an expiration time to the stored data item, before which time both modification and deletion are prohibited (see column 13, lines 10 – 11);

Whereby the stored data item is preserved and can be retrieved using the access authorization credential (column 2, lines 35 – 38) for an indefinite period after the content data item is no longer present at the network storage locations (see column 6, lines 40 – 42.

wherein the one of the multiple clients reassigns the expiration time to a later time (column 9, lines 13 – 15);

wherein no action taken by the one of the multiple clients can cause the expiration time to be changed to an earlier time or cause the stored data item to be deleted at an earlier time than the expiration time (Fig.4 step 2006 column 13, lines 10 – 11 and column 38, lines 49 – 51));

wherein after the expiration time has passed deletion of the data item is allowed (column 9, lines 17 – 18); and

wherein the indefinite period extends at least until the expiration time (fig.23).

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because Kanai's teaching of "digital fingerprint" would have allowed Heilig's system to monitor the authenticity of data transmitted. The motivation is that data integrity is preserved.

Further, Yuasa's teaching of "expiration time" would have allowed Heilig and Kanai's system to monitor data item's expiration time and delete data item that have expired time thereby creating storage space for the needed data.

Regarding claim 115, Yuasa discloses the data repository comprises a plurality of storage sites (Fig. 4 step 2007 and column 39, lines 13 – 15), and a set of rules governing the assignment of the expiration time are communicated to the plurality of storage sites (column 4, lines 11 – 20).

Regarding claim 116, Yuasa discloses the expiration time initially assigned to the stored data item depends upon an expiration times assigned by the one of the multiple clients (column 38, lines 61 - 62).

Regarding claim 164, Yuasa discloses wherein the data repository retains a copy of a plurality of the data items of content accessed by the one of multiple clients via the web proxy, thereby preserving the content after it has been altered or removed from the network (see column 6, lines 40 – 43).

Regarding claim 165, Heilig discloses wherein the one of the multiple clients uses a search engine to search the copy of the plurality of the data items of content accessed by the one of the multiple clients (see Fig.1 step 102).

Regarding claim 166, Heilig discloses using information maintained by the data repository, about the number of times that stored data items have been accessed by the multiple clients or how recently the data items have been accessed, in an algorithm that orders Web search results (page 11, [0159]).

Regarding claim 168, Yuasa discloses wherein the expiration time is assigned a value that indicates that the stored data item will never expire (column 38, lines 61 – 62).

Regarding claim 169, Heilig discloses wherein the network is the Internet, the one of the multiple clients is a Web browser program, the content data item is a Web page, and the one of the network storage locations is a Web server (Fig. 1 and page 7, [0101]).

Regarding claim 170, Yuasa discloses the method of claim 114 wherein the one of the multiple clients reads a data item from the data repository (page 1, [0011]).

Regarding claim 171, Yuasa discloses the method of claim 114 wherein the one of the multiple clients writes a data item to the data repository (page 1, [0011]).

Regarding claim 173, Yuasa discloses the method of claim 114 wherein, after tile expiration time has passed, file one of the multiple clients deletes the stored data item (column 9, lines 17 – 18).

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 571-272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fred I. Ehichioya/

January 18, 2008